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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES

Applicant(s) : Victor P. Laskorski
U.S. Serial No. : 10/039,511
Filed : January 4, 2002
For : **INSULATION MATERIAL**
Examiner : Alexander S. Thomas
Group Art Unit : 1772

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I hereby certify that this correspondence is being deposited with the United States Postal Service as first class mail in an envelope addressed to: Mail Stop Appeal Brief-Patents, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450, on February 2, 2005.

Ronald R. Santucci, Reg. No. 28,988

Name of Applicant, Assignee or Registered Representative

A handwritten signature of Ronald R. Santucci.

Signature

February 2, 2005

Date of Signature

REPLY BRIEF UNDER 37 C.F.R. 1.193(b)(1)

Mail Stop Appeal Brief-Patents
Commissioner for Patents
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Sir:

This Reply Brief is being filed in response to the Examiner's Answer dated December 2, 2004. This Reply Brief is filed in triplicate.

ARGUMENT

This Reply Brief is being filed in response to several points of argument raised by the Examiner in the Examiner's Answer. It is believed that no fee is required for the consideration of the Reply Brief. If, however, a fee is due, the Assistant Commissioner is authorized to charge such fee, or credit any over payment to Deposit Account No. 50-0320. Filed currently herewith is a Request for Oral Hearing, also in triplicate.

Claims 1, 2, 5-7 and 11 stand rejected under 35 U.S.C. §102(e) as allegedly anticipated by Published U.S. Patent Application No. 2002/0164465 to Curro et al. In addition claims 8-10 and 12-14 are rejected under 35 U.S.C. § 103(a) as unpatentable over Curro.

The claims of the instant application and in particular independent claims 1 and 5 recited in the preamble “[a]n insulation material comprising.” In paragraph 11, the Examiner has stated that the term “insulation” does not provide any structurally distinguishing features to the claimed article. The Examiner is reminded that where terms in the preamble “breathes life and meaning” into the subject matter of the claim, it is a necessary limitation of that claim. *Loctite Corp. v. Ultraseal Ltd.*, 228 U.S.P.Q. 90 (Fed. Cir. 1985). An insulation material clearly breathes life into the meaning of the claim. It is not simply an intended use, but rather connotes certain properties and physical attributes of the material which are well known to those of skill in the art and

would be apparent to even the casual reader of the claim. Thus it is respectfully

submitted that the Examiner's dismissal of the term insulation is in error.

Secondly, the Examiner makes the sweeping statement that "any article...possesses insulating properties." The Examiner is wrong. Not all materials possess insulating properties. Indeed the Examples discussed in Curro demonstrate the inaccuracy of this contention. The Examples in Curro are directed to materials which absorb fluid as a primary function. As is apparent to one of skill in the art fluid absorption is an antithetical property of insulator.

Applicants reiterate the objection to the allegations that the instantly claimed insulation material is "inherently" taught by Curro. Again, the Examiner's sweeping allegation that "any article, such as those disclosed in the reference, possesses insulating properties to a degree, whether they be heat, sound, electrical, etc. insulating properties" is not an adequate basis for rejecting the instant claims.

The Examiner is respectfully reminded that it is not enough to merely allege that because a document purportedly recites disparate materials that the document must "inherently" speak to the instantly claimed invention. Instead, the document must disclose or suggest the properties of the claimed invention for inherency to attach.

According to *In re Rijckaert*, 9 F.3d 1531, 1957 (Fed. Cir. 1993), "such a retrospective

view of inherency is not a substitute for some teaching or suggestion supporting an obviousness rejection.” The Federal Circuit is clear that “ ‘inherency...may not be established by probabilities or possibilities. The mere fact that a certain thing may result from a given set of circumstances is not sufficient [to establish inherency].’ ” *Continental Can Company v. Monsanto Company*, 948 F.2d 1264, 1269 (Fed. Cir. 1991), *citing to In re Oelrich*, 666 F.2d 578, 581-582 (C.C.P.A. 1981). Indeed, “before a reference can be found to disclose a feature by virtue of its inherency, one of ordinary skill in the art viewing the reference must understand that the unmentioned feature at issue is necessarily present in the reference.” *SGS-Thomson Microelectronics, Inc. v. International Rectifier Corporation*, 31 F.3d 1177 (Fed. Cir. 1994) (emphasis in original).

Against this background, as the cited documents do not disclose nor suggest the elements and properties of the claimed invention, the Section 102 rejections must fail as a matter of law.

For support of the inherent insulation teachings the Examiner cites to examples in Curro in which the formation of bedding and clothing is discussed. These arguments are misplaced the examples cited by the examiner describe an “interliner” of a garment and not an insulating material. It is well known in the art that interliners are not insulators but rather form a portion of a garment, which in combination with either a separate insulator material laminated to it or to an outer layer form an insulating garment. Another

possibility is the insertion of an unbound layer sandwiched between the inner and outer layers.

In contrast, the nature of the material of Curro is clearly described in paragraph 150 where a “cooling” treatment is described. In this example, the “absorbent” inner layer absorbs water which is used to cool the air by its passage there through. As previously discussed, this is not an insulating material.

Similarly the blanket described in paragraph 138 describes an inner layer formed of Always Dri-weaveTM material. This material, as with most examples in Curro is an absorbent material commonly used in pantyliners and other feminine hygiene products. Accordingly this is not an insulating material as recited in the independent claims of the present invention.

In view of the foregoing, the Examiner’s 102 rejection cannot stand because Curro nowhere disclose an “insulating material” and thus the reference fails to contain all the elements of claim 1. *See Lawmar Marine Inc. v. Barient Inc.*, 3 U.S.P.Q.2d 1766 (Fed. Cir. 1987); *In re Spada*, 15 USPQ2d 1655 (Fed. Cir. 1990). That is, to constitute anticipation, all material elements of a claim must be found in one prior art source. *In re Marshall* 190 USPQ 344 (CCPA 1978). Appellants further note that for anticipation, there must be no difference between the claimed invention and the reference disclosure.

Scripps Clinic & Res. Found. v. Genetech, Inc., 18 USPQ2d 1001 (Fed. Cir. 1988), and

thus exact identity is required.

As set forth above, Curro fails to contain each and every element of independent claims 1 and 5, and consequently, the anticipation rejection must fail as a matter of law.

For these reasons, Appellants submit that claims 1 and 5 is not shown by the reference relied upon by the Examiner, and Appellants respectfully request that the rejection of independent claims 1 and 5 under 35 U.S.C. § 102(e) be reversed.

Additionally, Appellants have indicated that claims 1, 2 and 5-14 stand or fall together.

Claims 2 and 6-14 depend, either directly or indirectly from independent claim 1 or claim 5 and therefore should also all be found allowable. Accordingly, Appellants respectfully request that the rejection of claims 2 and 6-14 under 35 U.S.C. § 102(e) and 35 U.S.C. § 103(a) also be reversed.

CONCLUSION

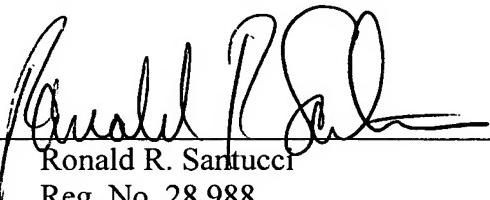
It is respectfully submitted that the Examiner erred in rejecting claims 1, 2 and 5-14, and therefore, Appellants request a reversal of these rejections by this Honorable Board. It is further submitted that the Examiner's objections/rejections and materials set

forth in the Examiner's Answer should be reversed and allowance of this application should be mandated.

Respectfully submitted,

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